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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,894	07/11/2003	Phillip J. Bouic	58670US004	4040
32692	7590	01/12/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 01/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/617,894		BOUIC ET AL.	
	Examiner		Art Unit	
	Hai Vo		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-22,27-43 and 45-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26,44 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0922</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The claim objections are maintained.
2. The double patenting rejections are maintained.
3. All of the art rejections are maintained.

Claim Objections

4. Claims 23-26, and 44 are objected. The objections have been maintained for the following reasons. Applicants argue that the amendment of depending claims based on the restriction is contrary to proper restriction practice. The examiner disagrees. Although the products of claims 1 and 26 are made from the same process, they are independent from each other and related to different product, i.e., unfoamed material vs. foamed material. Therefore, it is not seen that the incorporation of the limitations from claim 1 to claim 26 is contrary to proper restriction made on 06/15/2005.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 23-26, 44 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,797,361 substantially as set forth in the 08/02/2005 Office Action. The obviousness-type double patenting rejections have been maintained for the following reasons. Any polymeric articles made from a polymeric foam material with a surface pattern read on the claimed subject matter. Applicants argue that nowhere do the claims of the Patent '361 disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. The polymeric foam article of the patent '361 is provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area as shown in figures 1 and 2. Additionally, "the surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure" is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the foam article of Patent '361 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The masking strip is made from an open celled polyurethane foam having a density from 20 to 30 kg/m³ within the claimed

range. The masking strip has a plurality of grooves which read on Applicants' surface pattern. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the masking tape of Patent '361. Accordingly, the obviousness-type double patenting rejections are sustained.

7. Claims 23-26, 44 and 65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.10/617,893 substantially as set forth in the 08/02/2005 Office Action. The obviousness-type double patenting rejections have been maintained for the following reasons. Any polymeric articles made from a polymeric foam material with a surface pattern read on the claimed subject matter. Applicants argue that nowhere do the claims of the Application

No. 10/617,893 disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the foam article of the Application No. 10/617,893 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The masking strip is made from an open celled polyurethane foam. The masking strip has a plurality of ribs which read on Applicants' surface pattern. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the

Comparative Examples are commensurate in scope with the masking tape of the Application No. 10/617,893.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al (US 5,350,544) substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does Bambara disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. The examiner disagrees. Bambara teaches a rigid, closed cell polyethylene foam article provided with a surface pattern by applying pressure to the surface of the foam article (figure 2, column 4, lines 45-52). It is recognized that the process of Bambara is different from the process of the present invention. However, Bambara teaches a step of pressing a cold metal die with a

design onto the heated area to form a foam sheet product having a three-dimensional, foam-tread-wear surface, which on Applicants' desired shape by deforming the area under pressure. Accordingly, the art rejections are sustained.

10. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/52646 substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does WO '646 disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. The examiner disagrees. WO'646 teaches a foam strip for masking a gap between a movable panel 11 and another part 12 of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip (page 4, lines 10-20, figures 1-3), which reads on Applicants' desired shape by deforming the area under pressure. Accordingly, the art rejections are sustained.

11. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/46056 substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does WO '056 disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed

area. The examiner disagrees. WO'056 teaches a foam strip for masking a gap between two parts of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip, which reads on Applicants' desired shape by deforming the area under pressure (figures 1A, 1B, page 1, lines 30-33). Accordingly, the art rejections are sustained.

12. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Francis et al (US 4,996,092) substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does Francis disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. The examiner disagrees. Francis teaches a foam strip for masking a gap between a car door and a car body having a surface pattern formed by applying pressure to the surface of the foam strip, which reads on Applicants' desired shape by deforming the area under pressure (figures 1A, 1B, page 1, lines 30-33). Accordingly, the art rejections are sustained.

13. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Bouic (US 6,797,361) substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the same reasons set forth in the paragraph no. 3 which are believed to be pertinent.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 795 356 substantially as set forth in the 08/02/2005 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does EP'356 disclose or teach a polymeric article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that when the pressure is removed, the desired shape is produced in the deformed area. The examiner disagrees. EP'356 teaches a masking strip for temporarily masking automotive body gaps in paint-spraying operations. The masking strip is made from an open celled polyurethane foam having a density from 20 to 30 kg/m³ [0002] and [0020]. The masking strip has a plurality of grooves which read on Applicants' surface pattern as shown in figure 1. EP'356 does not specifically disclose how the grooves are formed on the surface of the masking strip. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of masking strip of EP'356 is identical to or only slightly different than the claimed article prepared by the method of the

claim, because both articles are formed from the same materials, having structural similarity. The masking strip for temporarily masking automotive body gaps in paint-spraying operations is made from an open celled polyurethane foam having a density from 20 to 30 kg/m³ within the claimed range. The masking strip has a plurality of grooves which read on Applicants' surface pattern. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the masking tape of EP'356. Accordingly, the art rejections are sustained.

Conclusion

16. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

**HAIVO
PRIMARY EXAMINER**